UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,016	01/29/1999	MASAMICHI ITO	35.C13284	5590

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EXAMINER
POON, KING Y

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/239,016	ITO, MASAMICHI
	Examiner	Art Unit	
	King Y. Poon	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 May 2005*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5,6,9,10 and 13-21* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5,6,9,10 and 13-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 March 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All   b)☐ Some * c)☐ None of:

   1.☒ Certified copies of the priority documents have been received..

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (e) the invention was described in
> (1) an application for patent, published under section 122(b), by another filed in the United States
> before the invention by the applicant for patent or except that an international application filed under the treaty
> defined in section 351 (a) shall have the effects under this subsection of a national application published under
> 122(b) only if the international application designating the United States was published under Article 21(2)(a) of
> such treaty in the English language; or (2) a patent granted on an application for patent by another filed in the
> United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in
> the United States for the purposes of this subsection based on the filing of an international application filed
> under the treaty defined in section 351(a).

2.   Claims 1, 2, 5, 6, 9, 10, 13-21 are rejected under 35 U.S.C. 102(e) as being

anticipated by Rhoads (US 6,122,403).

Regarding claims 1, 19: Rhoads teaches an image capture device (the computer

that is to reproducing an image, such as a video, column 72, lines 15-23, with added

watermarks, column 69, lines 49-56) which records data of a captured image on a

recording medium (the recording medium that stores the image file, column 69, lines 50-

60; since the computer is loaded with the image file, inherently, the computer must

process a memory for storing the image file to prevent the image file from being lost)

comprising: an image capture unit (the computer software that capture the image read

in from a CD ROM or Internet, column 69, lines 50-55, column 73, lines 55-60, that

would prevent the image from getting out of the computer or losing from the computer)

adapted to capture an image; an information generation unit (the computer program that

generates data of a logo that is being stored in a file of the computer, column 68, lines

40-45; other information can be generated are e.g., messages or user's name etc,

column 69, lines 10-30, column 73, lines 15-50) adapted to generate specific

information (e.g., ID, adult content information, logo, copyright symbol, column 73, lines

25-50, column 69, line 66; or noise signal, fig. 47, 972, fig. 24) relating to the image data

of the captured image; a recording unit adapted to record the image data and the

specific information on a recording medium (the recording medium in the computer that

stores the image file, column 69, lines 50-60 and the symbol, column 69, line 66, etc.); a

reproducing unit (the computer program that recover a watermarked image, column 69,

lines 57-67, column 70, lines 1-45) adapted to reproduce the image data and the

specific information from the recording medium (the memory of the computer that is

storing the image file, column 69, lines 49-56); and an embedding unit (writer, column

69, line 34) adapted to embed specific information (e.g., Creator ID, column 69, line 42)

reproduced from the recording medium (open an video or noise signal, fig. 47, fig. 51)

into the image data reproduced from the recording medium (open an image, column 73,

lines 55-60) using a digital watermarking technique (column 69, lines 32-35); and a

selection unit (the program of the computer that sense the OK selection and embedded

the watermark into image data, column 73, lines 45-50, or cancel the process, and the

software that downloads the image file to a local computer, column 69, lines 49-55,

column 72, lines 50-55) adapted to select a first process (embed the watermark, column

73, lines 45-50) or a second process (abort the process, column 73, lines 45-50) in

accordance with user's instruction, wherein when the first process is selected by the

user, the embedding unit embeds the specific information into the image data (column

73, lines 45-50); and when the second process is selected by the user, the embedding

unit avoids embedding the specific information into the image data (column 73, lines 45-

50).

Regarding claim 2: Rhoads teaches the image capture device further comprising

decompressing unit (recompress, column 71, lines 10-15, indicates the image has bee

compressed before, also see decompression, abstract, column 34, lines 25-35;

inherently, all decompression must requires a decompressing unit) adapted to

decompress the image data reproduced from the recording medium, wherein the

embedding unit is adapted to embed the specific information into the decompressed

image data. (Column 71, lines 10-15).

Regarding claims 13, 20: Rhoads teaches wherein the information generation

unit generates the specific information when the image is captured (column 69, lines 50-

56, column 72, lines 49-50).

Regarding claims 16, 21: Rhoads teaches the apparatus further comprising an

outputting unit adapted to output the image data to an external, wherein when the first

process is selected, the outputting unit outputs the image data including the specific

information to the external destination, and wherein, when the second process is

selected; the outputting unit outputs the image data excluding the specific information to

the external destination (column 72, lines 50-55).

Regarding claims 5, 6, 14, 17: Claims 5, 6, 14, 17 are claiming method steps for the apparatus discussed in claims 1, 2, 13, 16. Please see discussion on claims 1, 2, 13, 16.

Regarding claims 9, 10, 15, 18: Rhoads teaches to use a computer, running software programs (column 67, lines 55-62) for carrying out the method steps discussed in claims 1, 2, 13, 16. It is inherent that a software program is stored in a storage program.

Response to Arguments

3.   Applicant's arguments filed on 5/19/2005 have been fully considered but they are not persuasive.

With respect to applicant's argument that Rhoads does not teach an image capture device having 1) capturing an image, 2) generating specific information relating to the image data 3) recording the captured image and the specific information, and 4) selectively embedding the specific information generated by the image capture apparatus in the image capture by the image capture apparatus, has been considered.

In reply: Rhoads teaches an image capture device (the computer that is to reproducing an image, such as a video, column 72, lines 15-23, with added watermarks, column 69, lines 49-56) which records data of a captured image on a recording medium (the recording medium that stores the image file, column 69, lines 50-60; since the computer is loaded with the image file, inherently, the computer must process a memory for storing the image file to prevent the image file from being lost) comprising: an image

capture unit (the computer software that capture the image read in from a CD ROM or

Internet, column 69, lines 50-55, column 73, lines 55-60, that would prevent the image

from getting out of the computer or losing from the computer) adapted to capture an

image; an information generation unit (the computer program that generates data of a

logo that is being stored in a file of the computer, column 68, lines 40-45; other

information can be generated are e.g., messages or user's name etc, column 69, lines

10-30, column 73, lines 15-50) adapted to generate specific information (e.g., ID, adult

content information, logo, copyright symbol, column 73, lines 25-50, column 69, line 66;

or noise signal, fig. 47, 972, fig. 24) relating to the image data of the captured image; a

recording unit adapted to record the image data and the specific information on a

recording medium (the recording medium in the computer that stores the image file,

column 69, lines 50-60 and the symbol, column 69, line 66, etc.); a reproducing unit (the

computer program that recover a watermarked image, column 69, lines 57-67, column

70, lines 1-45) adapted to reproduce the image data and the specific information from

the recording medium (the memory of the computer that is storing the image file,

column 69, lines 49-56); and an embedding unit (writer, column 69, line 34) adapted to

embed specific information (e.g., Creator ID, column 69, line 42) reproduced from the

recording medium (open an video or noise signal, fig. 47, fig. 51) into the image data

reproduced from the recording medium (open an image, column 73, lines 55-60) using a

digital watermarking technique (column 69, lines 32-35); and a selection unit (the

program of the computer that sense the OK selection and embedded the watermark into

image data, column 73, lines 45-50, or cancel the process, and the software that

downloads the image file to a local computer, column 69, lines 49-55, column 72, lines 50-55) adapted to select a first process (embed the watermark, column 73, lines 45-50) or a second process (abort the process, column 73, lines 45-50) in accordance with user's instruction, wherein when the first process is selected by the user, the embedding unit embeds the specific information into the image data (column 73, lines 45-50); and when the second process is selected by the user, the embedding unit avoids embedding the specific information into the image data (column 73, lines 45-50).

With respect to applicant's argument that Rhoads teaches a web service generating information that is to be embedded in the image data, has been considered.

In reply: Column 72, lines 49-50, clearly teaches user CREATES and EMBEDS a watermark in the digital image.

With respect to applicant's argument that the scanner of Rhoads is not the image capturing device as claimed, has been considered.

In reply: The image capturing device in Rhoads is the computer as previously discussed. Capture has the meaning "to gain possession or gain control of." The computer of Rhoads clearly gains control and possession of the image. The computer can compress, decompress recompress the image, and even embed different watermark into the image (column 71, lines 5-15, column 72, lines 49-50).

4.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

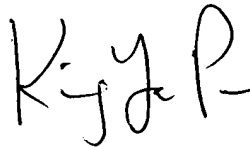than SIX MONTHS from the date of this final action.

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to King Y. Poon whose telephone number is 571-272-

7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Moore can be reached on 571-272-7437. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

August 18, 2005

KING Y. POON
PRIMARY EXAMINER